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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,878	03/31/2004	Tadashi Hayashi	00862.018049	4562

5514 7590 04/04/2006

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EXAMINER

OKEZIE, ESTHER O

ART UNIT PAPER NUMBER

3652

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/812,878	Applicant(s) HAYASHI, TADASHI	
	Examiner Esther O. Okezie	Art Unit 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 4,6,8,10,11,13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,2 and 12 is/are rejected.
- 7) ☐ Claim(s) 3,5,7 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/18/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of Species III in the reply filed on December 7, 2005 is acknowledged. The traversal is on the ground(s) that the various embodiments of Applicant's invention are closely related and would not require such a different search so as to overburden the Examiner. This is not found persuasive because Applicant has disclosed five distinct embodiments including, numerous robotic hand arrangements comprising single gripping fingers, double gripping fingers, gripping means with recessed portions, gripping means with joints for bending, gripping means with rotary joints capable of rotation, various manipulation liquid mediums, and various fluid control means among numerable variations.

It is well established practice that a requirement to elect a single species is a holding by the examiner that the plural species as claimed are patentably distinct (capable of supporting separate patents). See MPEP §808.01(a) and MPEP §809.02(a). If applicant is of a different view, applicant need merely state on the record that the species are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning. Note, species that are not patentably distinct are obvious in view of one another.

The requirement is still deemed proper and is therefore made FINAL.

Claims 4,6,8,10,11,13,14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable

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generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/7/05.

### ***Drawings***

Figures 16-19 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent 4-341438. Japanese Patent 4-341438 discloses a handling device comprising a contact portion (1a) for manipulation of a target object (6); a pressure chamber (4) and an opening (5) at said contact portion, said opening communicating with said pressure

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chamber, wherein the target object is manipulated by causing a fluid control means (15) to control inflow/outflow of a fluid through said opening (English abstract).

2. Claims 1,2,12 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent 9-201783. Japanese Patent 9-201783 discloses a micro-manipulator comprising a contact portion (1) for manipulation of a target object (6); a pressure chamber and an opening (2) at said contact portion, said opening communicating with said pressure chamber, wherein the target object is manipulated by causing a fluid control means to control inflow/outflow of a fluid through said opening (English abstract).

3. Re claim 2, a plurality of said openings (2) for which the inflow/outflow of the fluid can independently be controlled by the fluid control means at said contact portion to the manipulation target object, wherein the fluid control means moves the target object in a desired direction by executing at least one of ejection of the fluid from the openings located on an opposite side of the direction in which the target object should be moved (figs 3 and 4) and drawing of the fluid from the openings located on the same side as the direction target object should be moved (english abstract; see figs 1-4).

4. Re claim 12, the fluid control means is a temperature control means (English abstract).

***Allowable Subject Matter***

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Claims 3,5,7,9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 2002172457: see English abstract for fluid control suction and discharge controlled by temperature;

JP 2000010016A;

JP 4041187A;

JP 363222680A;

JP 2000232873A;

US 4,865,491;

US 6,494,646;

US 5,634,636;

US 6,447,217;

US 474,397


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esther O. Okezie whose telephone number is (571) 272-8108. The examiner can normally be reached on Mon-Thurs 8-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EOO 2/21/06



**EILEEN D. LILLIS**  
SUPERVISORY PATENT EXAMINER  
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